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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,792	02/24/2004	Kishio Shibato	ORI-17098.001	2181

40854 7590 09/05/2007
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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

MAIL DATE	DELIVERY MODE
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09/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,792

Applicant(s)

SHIBATO ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/26/07 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 and 14-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. The Applicants' amendment filed June 26, 2007 is acknowledged. Claims 1-9 and 11-13 are deleted. Claim 10 is amended. Now, Claims 10 and 14-21 are pending.

2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 102

3. Claims 10 and 14-21 under 35 USC 102(b) as being unpatentable over Yamamoto (US 6 103 387).

Yamamoto teaches a coating composition comprising component A) can be component A') (col. 25, lines 49-67) that is prepared by polymerizing a monomer mixture comprising a **hydroxyl** containing monomer (col. 27, lines 5-17), an **epoxy** containing monomer (col. 28, lines 9-28), a **carboxyl** containing monomer (col. 27, lines 18-42), etc., and component C) silica sol. (col. 25, lines 49-67) The amounts of the hydroxyl containing monomers and the epoxy containing monomers are described in col. 26, lines 52-60 and col. 28, lines 1-28. The amount

of component C) is described in Examples. Note that Yamamoto component A') reads on both Applicants' component F') and component B) because the present invention does not **exclude** the possibility of components F') and B) are the same. Yamamoto is silent on the polymerizing the monomer mixture in the presence of component C). However, with respect to later embodiment, these claims are product-by-process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

For Applicants' argument (Remarks, page 8, 2nd paragraph to page 9, last paragraph), Examiner disagrees because Yamamoto's teaching set forth in col. 25, lines 49+ was relied upon, rather than that set forth in col. 10, lines 58+ (including col. 11, lines 11-12 as Applicants pointing out). Note that in teaching that was relied upon, there is no "very long list of monomers" for preparing component A'). (col. 26, line 64 to col. 28, lines 28)

For Applicants' argument (Remarks, page 10, 1st paragraph), Applicants are reminded that the specific advantage of utilizing monomer of formula (3) is not claimed. Furthermore, since Yamamoto teaches the use a monomer that reads on Applicants' formula (3), the resulting coating should have the same characteristic as that alleged, unless Applicants can show any unexpected results. However, Applicants are reminded that the specific advantage of utilizing monomer of formula (3) is not claimed. Furthermore, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)

4. Claims 10 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nambu (EP 1 013 730).

The following column and line numbers are based on Nambu's U.S. equivalent, US 6 316 572.

Nambu discloses a stain resistant coating composition comprising component A) prepared by polymerizing a mixture of compound x) an **epoxy** containing radical polymerizable monomer and compound y) a **carboxyl** containing vinyl monomer; component B) and component C). (col. 2, line 22 to

col. 3, line 9) Compound y) can further contain a **hydroxy** group. (col. 3, lines 23-34) **Hydroxy** containing monomers can also be used for preparing component A) (col. 7, lines 43-62) Other monomers such as methyl (meth)acrylate, etc. can be used for preparing component A). (col. 6, lines 39-67) Component C) can be a **non-polymerizable organosilicate** as described in col. 17, lines 38-62. The amounts of components x), y) in component A) and component C) are exemplified in Examples. Nambu is silent on polymerizing the mixture of compound x) and compound y) in the presence of component C). However, these claims are product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Component B) can contain carboxylic acid or anhydride, etc. (col. 14, lines 15-53) The amounts of components A), B) and C) are described in col. 4, lines 39-44, col. 16, line 64 to col. 17, line 9 and Examples. Nambu further teaches a method of coating as described in col. 21, line 6 to col. 22, line 25 and Examples.

For Applicants' argument (Remarks, page 11, 2nd paragraph), Applicants argue, "The monomers have already been polymerized to form resins when they first contact component (C)." However, Applicants have not yet shown the difference between a composition derived from polymerizing Applicants' monomers i)-iii) *in-situ* the organosilicate of formula (2) and a composition derived from mixing a polymer derived from polymerizing monomers i)-iii) and the organosilicate of formula (2). Applicants appear to allege that, by the *in-situ* method, the organic groups of formula (3) are useful for orienting ingredient C) effectively on the surface of the paint film. However, Applicants are reminded that the specific advantage of utilizing monomer of formula (3) is not claimed. Furthermore, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) Applicants further argue that, "Thus, Nambu et al. is similar to Yamamoto et al. in its teachings in that it suggests reacting a precursor acrylic resin with an organosilicate." Since Applicants' ingredients contain the same functional groups as Nambu's ingredients, the organosilicate can react with both ingredients.

5. Claims 10, 14-15 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP847 (JP 11-116847).

JP847 discloses a stain resistant coating composition comprising an organic resin A) and a non-polymerizable organosilicate B) of formula I. ([0012]-[0018] and [0089]) Component A) can contain can be derived from monomer mixture comprising hydroxy containing monomers such as polyoxyalkylene glycol mono-(meth)acrylate, etc.) and epoxy containing monomers. ([0029]-[0030]) JP847 is silent on the specific process of polymerizing the monomer mixture in the presence of component B). However, these claims are a product-by-process claims. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The monomer mixture for preparing component A) can comprise monomers containing carboxylic acid or anhydride groups. ([0030]) JP847 further teaches a method of coating. ([0110]-[0112] and Examples)

For Applicants' argument (Remarks, page 12, 2nd paragraph), However, Applicants are reminded that the specific advantage of utilizing monomer of formula (3) is not claimed. Furthermore, the arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,


will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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klp
August 30, 2007



Kuo-Liang Peng
Primary Examiner
Art Unit 1712